

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** ROGER MARK

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Appeal No. 97-1835  
Application 08/178,068<sup>1</sup>

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HEARD: April 8, 1999

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Before FRANKFORT, PATE and McQUADE, ***Administrative Patent Judges.***

PATE, ***Administrative Patent Judge.***

**DECISION ON APPEAL**

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<sup>1</sup> Application for patent filed January 6, 1994.

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This is an appeal from the final rejection of claims 1 and 3 through 14. These are all the claims that remain in the application.

The claimed invention is directed to a shock absorbing system for a housing such as a high fidelity speaker. The shock absorbing system is characterized by an energy absorbing material with special energy absorbing characteristics on the corners of the speaker. The energy absorbing material has a resistance to impact as shown in Figure 4 of the application.

The claims at issue on appeal are appended to appellant's brief.

The references of record relied upon by the examiner as evidence of obviousness are:

Mautner 1954	2,674,433	Apr. 6,
McClive 1962	3,063,613	Nov. 13,
Smith 1975	3,922,408	Nov. 25,
Meyer 1993	5,218,176	June 8,

***REJECTIONS***

The examiner has rejected claims 1, 4, 5 and 8 through 12 under 35 U.S.C. § 102(b) as anticipated by Mautner. The examiner has found that the protective rubber 8 of Mautner inherently exhibits high stiffness under normal operating conditions and low stiffness during impact.

The examiner has rejected claims 1, 3, 6, 8, 9, 13 and 14 under 35 U.S.C. § 102(e) as anticipated by Meyer. It is the examiner's finding that Meyer's material, closed cell foam

of the urethane type, such as that used by appellant, would have inherently exhibited high stiffness under normal operating conditions and low stiffness during impact.

The examiner has rejected claims 1, 6, 8 and 9 under 35 U.S.C. § 102(b) as anticipated by Smith. Again, the examiner has found that Smith's yieldable material inherently exhibits high stiffness during normal operation and low stiffness (that it will yield) during impact.

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The examiner has rejected claims 1, 4 and 8 through 10 under 35 U.S.C. § 102(b) as anticipated by McClive. According to the examiner, McClive supports a finding that the yieldable material disclosed therein inherently exhibits high stiffness during normal operation and low stiffness during impact.

The examiner has rejected claim 7 under 35 U.S.C. § 103 as unpatentable over Smith in view of Mautner. According to the examiner, it would have been obvious to use screws to mount the corner caps of Smith following the disclosure of Mautner.

The examiner has rejected claims 13 and 14 under 35 U.S.C. § 103 as unpatentable over McClive in view of Meyer. McClive does not disclose that the housing therein is used as a loudspeaker cabinet. The examiner has concluded that it would

have been obvious to use the McClive enclosure as a loudspeaker cabinet following the teaching of Meyer.

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We further note that the examiner has appended two references to the final rejection and the examiner's answer. The first reference appears to be a copy of page 468 of the ***Proceedings of the Polyurethane 1994 Conference***. The second reference appears to be page 53 of the ***Standard Handbook for Mechanical Engineers***. Where a reference is relied upon to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in a statement of the rejection. ***In re Hoch***, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). We will comment on the contents of these unapplied references ***infra***.

The examiner has noted that appellant's brief includes a statement that claims 1 and 3 through 14 do not stand or fall together and appellant provides sufficient reasons therefore under 37 CFR § 192(c)(7). Accordingly, appellant's claims do not stand or fall together.

#### ***OPINION***

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a

result of this review, we have reached the determination that the applied prior art does not support a finding of anticipation or a ***prima facie*** case of obviousness with respect to the claimed subject matter on appeal. Accordingly, the rejections on appeal are reversed. Our reasons follow.

Anticipation under 35 U.S.C. § 102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." ***In re Robertson***, 169 F.3d 743, \_\_\_\_, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting ***Verdegaal Bros., Inc. v. Union Oil Co.***, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the reference, and that it would have been so recognized by persons of ordinary skill. ***Robertson***, 169 F.3d at \_\_\_\_, 49 USPQ2d at 1950-51 (quoting ***Continental Can Co. v. Monsanto Co.***, 948 F.2d 1264, 1268, 20

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USPQ2d 1745, 1749 (Fed. Cir. 1991)). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at \_\_\_\_\_, 49 USPQ2d at 1951 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

Claim 1, the independent claim on appeal, includes a shock absorbing material exhibiting first, second and third stiffnesses. The material is further defined as having a first and third stiffness significantly higher than said second stiffness.

We have carefully reviewed the four references the examiner has cited as anticipatory. Therein, we find no express disclosure of appellant's claimed first, second and third stiffnesses. While we acknowledge that the examiner has stated that these stiffness properties are inherent in the references, it is clear that this finding of inherency is based merely on speculation and conjecture on the part of the examiner. However, inherency may not be established by mere possibilities or probabilities. Evidence of inherency must

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make clear that the missing descriptive material is necessarily present in the reference and it would so have been recognized by persons of ordinary skill. *See Robertson*, 169 F.3d at \_\_\_\_, 49 USPQ2d at 1950-51.

The examiner further contends that the unapplied references show that the stiffness characteristics claimed in claim 1 are "true for virtually all materials with some degree of resiliency." Answer, page 7. With regard to the first of those references, we note the first cited graph is a stress v. strain curve illustrating **creep** for a foam automobile seat. Creep, of course, is the tendency of a material to deform under sustained loading. Impact connotes instantaneous loading. Therefore, while the graph appears to depict the three slopes necessary to satisfy appellant's three claimed stiffnesses, it can be seen that a creep test has little relevance to the claimed invention and certainly will not support the examiner's finding of inherency. With respect to the second uncited reference, we merely note that the steel is



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deforming plastically after the elastic limit is reached, and it is improper to refer to the stiffness or Young's modulus after the yield point of the material has been reached.

Therefore, even if it were proper for us to consider the uncited references as extrinsic evidence bearing on the inherency issue, the uncited references provide no evidence that the properties claimed in claim 1 are inherent in any of the four cited references.

With respect to claims 7, 13 and 14 rejected under 35 U.S.C. § 103, the combinations of references in the rejections of the examiner do not establish a *prima facie* case of obviousness. For the same reasons given above, the subject matter of these claims has not been shown to have been unpatentable by the examiner.

***SUMMARY***

The rejection of all claims on appeal is reversed.

***REVERSED***

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	CHARLES E. FRANKFORT	)	
	Administrative Patent Judge	)	
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		)	BOARD OF
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	WILLIAM F. PATE, III	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES			
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		)	
	JOHN C. McQUADE	)	
	Administrative Patent Judge	)	

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